

Holt
Serial no. 09/683,292
Filed 12/10/2001
Attorney docket no. 1044.012US1

Page 6

REMARKS

Extension of time

The three-month period for responding to the current office action expired on November 26, 2004. Therefore, Applicant has submitted herewith an extension of time to extend the period of reply by one month, to December 26, 2004, and has paid the associated fee.

Examiner interview

Applicant's representative, Michael Dryja, conducted a telephonic interview with the Examiner, John Young, on December 15, 2004. Three issues were discussed. First, Applicant believed that the Examiner did not consider the limitation of the claimed invention, as specified in the independent claims, in which "the user is paid for access to the desired second sub-set of the personal information regarding the user without the user having to perform any action." The Examiner indicated that Applicant should submit an office action response in which it is indicated that this limitation was not considered, and in response the Examiner would attempt to locate the limitation in Ferguson (5,819,092); if the Examiner could not find the limitation in Ferguson, then he would conduct another prior art search.

Second, Applicant requested clarification as to the drawings being considered informal when Applicant considers them formal. The Examiner noted that the acceptability of the drawings is not determined by the Official Draftsperson until the patent application has been allowed for issuance, and therefore there is nothing further Applicant needs to do now. Applicant reiterated that it is believed the drawings are in formal condition.

Third, Applicant requested direction as to what to do with the missing Forms 1449 that were submitted in the two Information Disclosure Statements (IDS's) of January 7, 2002, and April 2, 2002. The Examiner stated that Applicant should submit the missing Forms 1449 with the next office action response.

Holt
Serial no. 09/683,292
Filed 12/10/2001
Attorney docket no. 1044.012US1

Page 7

Drawings

Per the Examiner interview, Applicant acknowledges that the final acceptability of the drawings will not be determined until the patent application has been allowed for issuance, although Applicant again submits that the drawings are in formal condition.

Forms 1449

Per the Examiner interview, Applicant has attached to this office action response copies of the Forms 1449 previously submitted with the IDS's of January 7, 2002, and April 2, 2002. Copies of non-patent references have also been attached. Consideration of these references is requested, and the initialed Forms 1449 indicating such consideration requested to be reported with the next office action.

Patentability of claimed invention

Per the Examiner interview, Applicant submits that the Examiner did not locate the following aspect of the claimed invention in Ferguson, in rejecting the claimed invention over Ferguson under 35 USC 103(a): "the user is paid for access to the desired second sub-set of the personal information regarding the user WITHOUT the user having to perform any action." Applicant indeed notes that Ferguson teaches away from this aspect of the claimed invention. For example, on page 5 of the most recent office action, the Examiner quotes Ferguson as providing a means in which "a user may be paid for certain actions" (col. 4, ll. 62-67). That is, in the claimed invention, the user is paid for access to his or her information without the user having to perform any action, whereas in Ferguson, the user is only paid when he or she performs an action. For instance, as also indicated on page 5 of the most recent office action, "a user may be paid when that user fills out a marketing questionnaire" (col. 4, ll. 60-67).

Holt

Page 8

Serial no. 09/683,292

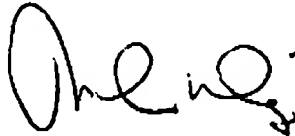
Filed 12/10/2001

Attorney docket no. 1044.012US1

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Applicants' Attorney so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



December 17, 2004

Date

Michael A. Dryja, Reg. No. 39,662
Attorney/Agent for Applicant(s)

Law Offices of Michael Dryja
704 228th Ave NE #694
Sammamish, WA 98074
tel: 425-427-5094
fax: 206-374-2819